

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Takuya Tsukagoshi
Application No. : 10/796,394
Filed : March 9, 2004
For : HOLOGRAPHIC RECORDING AND REPRODUCING
APPARATUS

Examiner : Arnel C. Lavarias
Art Unit : 2872
Docket No. : 890050.468
Date : August 24, 2007

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.182

Commissioner for Patents:

Applicant hereby petitions the U.S. Patent Office to enter an amendment filed on July 25, 2007, after the filing of the Notice of Appeal but before the filing of the Appeal Brief. According to 37 CFR 41.33, amendments filed after the Notice of Appeal but before the filing of the Appeal Brief may be admitted as provided in 37 CFR 1.116.

The Examiner refused entry of an amendment that the applicant believes complied with the rules and should have been entered. The Examiner's refusal to enter the amendment was improper. Thus, Applicant petitions the U.S. Patent Office to enter the amendment submitted on July 25, 2007. A copy of the amendment is attached to this petition for the convenience of the Office.

I. The relevant facts are as follows:

1. Claim 1 was pending in the application following an amendment filed on September 11, 2006.

2. The Examiner issued an Office Action on October 25, 2006 rejecting claim 1, as then pending, based on prior art grounds.

3. Applicant submitted an amendment that inserted a 17-word phrase into claim 1 without making any deletions or other changes to claim 1.

4. The Examiner rejected the amended claim 1 under 35 U.S.C. §112 on the basis that the inserted phrase was new matter and was not supported by the specification as filed. Amended claim 1 was further rejected on the same prior art grounds as in the previous Office Action of October 25, 2006. Such rejections were set forth in a final Office Action dated March 13, 2007.

5. A Notice of Appeal was filed on June 13, 2007.

6. An amendment was filed on July 25, 2007, removing the inserted 17-word phrase from claim 1. The removal of the phrase from claim 1 merely removed from the claim that language which the Examiner stated had no support in the specification and returned the claim to the exact language that was pending for the October 25, 2006 Office Action.

7. An appeal brief was filed on August 13, 2007, addressing only the section 103 rejections since language which had been rejected under section 112 had been removed by way of the July 25, 2007 amendment.

8. The Examiner issued an Advisory Action having a mailing date of August 10, 2007,¹ stating that the July 25, 2007 amendment will not be entered because:

(I) The amendment raises new issues that would require further consideration and/or search. The Examiner further asserted that the proposed amendment alters the scope of the pending claims, such scope having not been considered in the rejections in sections 9-12 of the March 13, 2007 Office Action.

(II) The amendment is not deemed to place the application in better form for appeal.

¹ Although the Advisory Action has a mailing date prior to the filing date of the Appeal Brief, the Advisory Action was received in the law firm's mailroom on the same day the Appeal Brief was filed and therefore was not placed in the record or provided to the agent's office until after the Appeal Brief was filed.

Applicant disagrees with these grounds of refusal and requests entry of the amendment.

II. Arguments to support entering the amendment

The Examiner's reasons to refuse entry of the July 25, 2007 amendment are incorrect.

A. **The amendment does not raise new issues**

The removal of rejected language from claim 1 merely returns the claims to the exact language that was pending before the Examiner when the Examiner issued a prior Office Action. The claim scope considered by the Examiner when issuing the previous October 25, 2006 Office Action was identical to the claim scope considered by the Examiner when issuing the Advisory Action. Thus, having the amendment entered would not require further consideration and/or search.

The scope is identical to that considered in sections 9-12 of the March 13, 2007 Office Action. The statement in the Advisory Action that the scope is different is not correct.

The Examiner's statement that the proposed amendment raises new issues is incorrect. Since the claim language is identical to the very same claim language the same Examiner has reviewed and considered, there cannot be an assertion that it raises new issues. In particular, merely returning claim 1 to its original language under which it was previously searched and considered in the Office Action of March 13, 2007 does not raise new issues.

For these reasons, the amendment should be entered.

B. **The amendment reduces the issues for appeal**

The final Office Action of March 13, 2007 set forth a 112 rejection and several 103 rejections, based on prior art grounds. The amendment removes the language that was rejected under section 112 and effectively causes the 112 rejection to be moot. The removal of the 112 rejection allows for an appeal to be filed addressing only the 103 rejections which are based on the prior art grounds. Thus, such amendment reduces the number of issues to be reviewed by the Board of Patent Appeals, thereby simplifying or otherwise placing the application in better form for appeal. Without the 112 issues, the appeal can proceed on the merits.

Clearly, the Examiner's position that an amendment whose sole effect is to remove language that was rejected under section 112 does not place the case in better form for appeal is in error. In fact, it does place the case in better form for appeal. An appeal with no

rejection under section 112 has fewer issues and will reduce the burden of topics to be considered.

For these reasons, the amendment should be entered.

The Director is authorized to charge payment of the Petition fee in the amount of \$400 to our Deposit Account No. 19-1090.

Should the Examiner have any additional questions, he is respectfully encouraged to contact the undersigned agent at (206) 622-4900.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC

/Ronald Stern/
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RS:vsj

Enclosure:

Copy of July 25, 2007 amendment

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